

REMARKS

This paper is in response to the Office Action mailed on February 7, 2003. A Petition for Three Month Extension of Time, with a check in the amount of \$465.00 for a three month extension of time, to and including August 7, 2003, is enclosed. In the event any additional fees are necessary, kindly charge the cost thereof to our Deposit Account No. 13-2855. It is respectfully submitted that the Examiner should withdraw the rejections to claims 1-6 and 15-23, and allow the claims to pass to issuance, in view of the following:

I. The references, combined in the manner suggested in the Office Action, even when including the design considerations within the level of skill of one skilled in the art, relied upon in the rejections under 35 U.S.C. § 103, fail to teach all limitations of the claims pending in the application.

In the Office Action, claims 1, 4, 6, and 19 are rejected as being unpatentable over Zoeller et al., U.S. Patent No. 6,136,190, in view of Nurse, U.S. Patent No. 5,580,453, and further in view of Morrison, U.S. Patent No. 901,545. According to the Office Action, Zoeller discloses a tee comprising all limitations of claims 1 and 6, with the exceptions that Zoeller fails to disclose that the cylindrical main body portion is elongated and that the inlet/outlet hub is sized to receive a pipe of a first outer diameter and being adaptable to receive a pipe of a second outer diameter.

The Office Action does not set forth a *prima facie* case of obviousness, as required for a rejection under 35 U.S.C. § 103, inasmuch as there is no motivation to a person of ordinary skill in the art to combine the elongated body of the tee in Nurse, U.S. Patent No. 5,580,453, with the tee of Zoeller, U.S. Patent No. 6,136,190, modified to have an inlet/outlet hub that has a diameter sized so as to receive a pipe of a first outer diameter and being adaptable to receive a pipe of a second outside diameter. According to Zoeller, a separate expansion piece (30) may be used to

extend the length of the tee. The tendency for installers to cut off a relatively short portion of a 10' length of commercially available PVC pipe, for example 12", and use that short length of pipe as the expansion piece, was one of the factors that motivated the conception of the invention as claimed in the present application. (See Meyers Supplemental Affidavit, ¶ 4).

It is respectfully submitted that Zoeller's showing of a separate expansion piece actually teaches away from the use of an elongated main body portion as claimed in the present application. If it were obvious to provide an elongated main body portion in a tee having a cylindrical uppermost hub having an inner diameter greater than a diameter of the tee's main body portion, and an inlet/outlet port with an inlet hub, Zoeller (which was filed two and a half years after the Nurse patent issued) would have been expected to teach the use of an elongated main body portion. Instead, Zoeller teaches only the wasteful and time consuming use of an expansion piece to cover a filter received within the tee.

As opposed to a proper, suggested combination of references that might support a rejection, the proposed combination of Zoeller and Nurse amounts to impermissible hindsight reconstruction. Hindsight reasoning guided by the Applicant's disclosure may not be used as the basis of a rejection under § 103(a). *In re Fritch*, 23 USPQ2d 1780, 1784; *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

To the extent the Office Action's inclusion of the language "by the use of a reducer" applies to claim 1, the Applicant respectfully submits that claim 1 does not require that there be a reducer bushing present in order to adapt the inlet/outlet hub in order to receive a pipe of a second outer diameter, and that particularly in light of the inclusion of dependent claim 6, claim 1 is not so limited.

The Morrison reference is relied upon in the Office Action for allegedly teaching that it is known in the art to have a tee adapted to receive a pipe of a first or second outer diameter by using a reducer. As all rejections in the Office Action are understood to be based on this reading of Morrison, the Applicant respectfully traverses all such rejections in the Action. Contrary to the indication in the Office Action, a close inspection of the Morrison reference, including Figure 8, reveals that it does not disclose a tee adapted to receive a pipe of two different diameters.

Rather, Morrison teaches standard slip-fit pipe fittings in sanitary plumbing tees connected in series, in which packing, such as oakum and lead for caulking, is applied around the exterior of one tee in the hub of another tee. As indicated on page 2 (column 3), line 64 of Morrison, Figure 8 does not show an ability, whether via a reducer or otherwise, to adapt a hub from mating with a pipe of a first diameter, to mate with a pipe of a second diameter. Instead, Fig. 8 shows only a ring a^6 , in the form of a stop member, "inserted in the hub to stop the end of the succeeding tee and the packing therefore." Thus, the reference does not teach that it is known to have a tee adapted to receive a pipe of a first or second outer diameter.

There is no teaching of a pipe received inwardly of the ring (a^6). The vertical lines in the drawing of Figure 8 (to the interior of the cross-sectional representation of the ring) represent the interior of the ring, not part of a pipe received within the ring. Contrary to the purpose of the use of the ring (a^6) in Morrison as a stop, the presence of a pipe received inwardly of the ring (a^6) would have to be sealed within the ring with some type of caulk, such as the oakum and lead described in the specification of Morrison. This would require introducing a slip joint, including caulk, into the soil pipe, which is what Morrison expressly indicates is being avoided by providing the ring (a^6) in the first place.

The Applicant further traverses the rejection of claim 21, and those claims depending therefrom. It is respectfully submitted that Ramm does not disclose the use of ribs extending along an elongated main body portion as recited in the claims. As discussed above, it would not have been obvious to a person of ordinary skill in the art to modify the tee of Zoeller to include the elongated body of Nurse. The bases (12) with mating surfaces (14) in Ramm are areas of weakness of the two-piece pipe fitting shown in Ramm, as opposed to strengthening ribs. This is because they are the seams at which the two halves are connected, and thus where the pipe fitting is most subject to leakage. Therefore, no motivated combination of Ramm with Zoeller, Nurse, and Morrison would result in the invention as recited in claim 21.

Claim 5 recites the presence of at least one horizontal reinforcement rib on an outer wall of an elongated main body portion. However, neither Ramm, nor any of the other references listed in the Office Action, teach or suggest the use of a horizontal reinforcement rib, much less a horizontal reinforcement rib on an elongated main body portion. By providing at least one horizontal reinforcing rib, the ability of the Applicant's tee to be constructed with a thin wall over most of its elongated height, but also simulate a thicker wall, such as Schedule 40-sized pipe, at the hubs, is enhanced, because a longer thin-walled tee is thereby made possible.

Paragraphs 4-8 of the accompanying Supplemental Affidavit of Theodore W. Meyers present the Applicant's reasons why the art relied upon in the rejections set forth in the Office Action do not render obvious the claims pending in the application.

II. The Examiner failed to adequately consider, and give proper weight to, the unrefuted Affidavit of Theodore W. Meyers Under 37 C.F.R. §1.132 and to the evidence of non-obviousness presented therein.

In *In re Alton*, 37 USPQ2d 1578, 76 F.3d 1168 (Fed. Cir. 1996), the Federal Circuit found that the examiner and the Board erred by failing to articulate adequate reasons to rebut a declaration submitted under 37 C.F.R. § 1.132, and held that:

The examiner also erred by dismissing the Wall declaration without an adequate explanation of how the declaration failed to overcome the *prima facie* case initially established by the Board.... Once the examiner or Board carries the burden of making out a *prima facie* case of unpatentability, "the burden of coming forward with evidence or argument shifts to the applicant." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444.... "After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument." *Id.* at 1445, 24 USPQ2d at 1444.

The Office Action of February 7, 2003 improperly gave no weight whatsoever to the Applicant's objective evidence of non-obviousness in the form an affidavit and data demonstrating remarkable commercial success, as well as copying by others. This dismissive treatment of such evidence is contrary to well-settled Federal Circuit precedent *requiring all evidence* of secondary considerations of non-obviousness to be considered. *See, e.g., Simmons Fastener Corporation v. Illinois Tool Works, Inc.*, 222 USPQ 744, 739 F2d 1573 (Fed. Cir. 1984); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555, 220 USPQ 303, 314 (Fed. Cir. 1983):

Objective evidence of nonobviousness, when present, must always be considered before reaching a legal conclusion under §103. *Stratoglex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). "Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not." *Id.*

Having determined that the invention would have been obvious in view of the process of either Smith or Sumitomo, the district court did not discuss the strong

showing of objective evidence of nonobviousness here present, saying with respect to one part of such evidence, "no amount of commercial success can save it." That approach was error. All evidence bearing on the issue of obviousness, as with any other issue raised in the conduct of the judicial process, must be considered and evaluated before the required legal conclusion is reached. [*Citing Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d at 1538, 218 USPQ at 879 (Fed. Cir. 1983).]

The obviousness rejections set forth in the February 7, 2003 Office Action essentially simply re-hash the same obviousness rejections made in the previous office actions. The Office Action therefore amounts to improperly raising the standard from a rebuttable presumption of obviousness to an irrefutable, or conclusive presumption-- a practice which the Board of Patent Appeals and Interferences expressly condemned in *Ex parte Ohsaka*, 2 USPQ2d 1460 (Bd.Pat.App.&Int. 1987) (refusing to sustain a rejection based on obviousness under 35 U.S.C. § 103 where the examiner dismissed the applicant's declaration under 1.132 as unconvincing "for the reasons given in support of the [initial] conclusion [of obviousness]."):

The flaw with this approach is that the examiner has, in practical effect, converted a rebuttable presumption into a conclusive or irrebuttal presumption of obviousness. The examiner incorrectly reverts to his initial conclusion of obviousness, finding the declaration evidence unconvincing "for the reasons given in support of the [initial] conclusion". Moreover, we note the examiner's assertion that the declaration results are "inherent" in the use of a-aluminum fluoride. The examiner does not assert, nor would he have basis on this record to assert, that the superior results obtained by using a-aluminum fluoride and shown in the Ohsaka declaration are expected. The rejection here is based on section 103 and appellants are entitled, if they choose, to file and rely on rebuttal evidence. As stated in *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976), "[w]hen prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over. . . . An earlier decision should not, as it was here, be considered as set in concrete". Again, as stated in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) "the examiner must consider all of the evidence anew..."

Even in the event a prima facie case of obviousness has been established, a premise which the Applicant disputes, the Applicant satisfied his burden, through his original Affidavit, as well as through his Supplemental Affidavit filed herewith, of establishing through secondary

considerations of non-obviousness, including documented demonstrations of commercial success and copying by others, that the claims pending in the application are allowable over the prior art.

As indicated in the accompanying Supplemental Affidavit of Theodore W. Meyers Under 37 CFR §1.132 and the appendices thereto, Tuf-Tite has experienced ongoing commercial success in the form of sales of the T-BAFFLE tees that are made in accordance with the claims of the present application. To wit, in the past twelve months Tuf-Tite's sales data reflects a quantity of 59,982 T-BAFFLES shipped by Tuf-Tite, the assignee of the present application. Supplemental Affidavit, at ¶10. While a small percentage (less than 1%) of these were tees provided as free samples to customers, based on the Applicant's some 20 years of experience in this industry, these figures, and the sales figures from the previous two years, reflect a substantial commercial success for the T-BAFFLE tees. Supplemental Affidavit, at ¶¶ 9, 11.

The Supplemental Affidavit also sets forth, in Appendix B, a state-by-state listing of the quantity of T-BAFFLE tees shipped by Tuf-Tite. Tuf-Tite realized rapid growth of sales of T-BAFFLE tees in several states in particular, such as California, Georgia, Maine, Arizona, Michigan, Ohio, and Missouri. Supplemental Affidavit, at ¶ 13. The Applicant states in his Supplemental Affidavit that "[a]t least some of this growth is believed to be attributable to regulatory approvals finally occurring in certain counties or municipalities of such states, before which time precasters and installers of septic tanks and other on-site waste facilities that employ tees and filters were unwilling or unable to use T-BAFFLE tees in their jurisdictions." *Id.* Thus, it is fair to predict that Tuf-Tite's commercial success will grow as the T-BAFFLE tee obtains additional regulatory approvals.

Appendix C to the Supplemental Affidavit is submitted to substantiate and corroborate the Applicant's citation of secondary evidence in the form of copying by others. Specifically, as

set forth in detail in the Applicant's prior Affidavit, a competitor copied a significant portion of the claimed features of the Applicant's T-BAFFLE tees. Since the prior Affidavit, Tuf-Tite still has not sold a single T-BAFFLE tee to that competitor, despite continued sales of other product. As indicated in the Applicant's prior Affidavit and the appendices attached to that Affidavit, the competitor stopped purchasing T-BAFFLE tees from Tuf-Tite just a few months before introducing its product, the "Filter Tee."

CONCLUSION

In view of the lack of a *prima facie* case of obviousness, and the significant persuasive evidence of secondary considerations of non-obviousness that are sufficient to overcome a presumption of obviousness even in the event a *prima facie* case of obviousness has been established, the Applicant respectfully submits that the claims pending in the application are allowable. The Examiner's reconsideration and favorable action are respectfully requested. In the event the Examiner has any questions that might be resolved by telephone, he is invited to contact the Applicant's undersigned representative at (312) 474-6300.

Respectfully submitted,



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